



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2014 TMOB 104**  
**Date of Decision: 2014-05-20**

**IN THE MATTER OF AN OPPOSITION by  
Philip Morris Products S.A. and Philip Morris  
Brands Sarl to application No. 1,495,068 for the  
trade-mark CLICK SWITCH REFRESH THE  
TASTE in the name of British American  
Tobacco (Brands) Limited**

FILE RECORD

[1] On September 8, 2010, British American Tobacco (Brands) Limited, located in London, United Kingdom, filed an application to register the mark CLICK SWITCH REFRESH THE TASTE, based on proposed use in Canada, in association with the following wares:

cigarettes; tobacco; tobacco products; lighters; matches; smokers' articles namely ashtrays, cigarette cases, and tobacco pipes.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated March 9, 2011 and was opposed by Philip Morris Products S.A. ("PMPSA") and Philip Morris Brands Sarl on July August 9, 2011. The Registrar forwarded a copy of the statement of opposition to the applicant on September 1, 2011, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponents' evidence consists of (i) the affidavit of Anna Di Domenica, (ii) certified copies of the file wrappers (or extracts thereof) of trade-mark applications for the marks KLIK PACK; CLICK; and CLICK & ROLL, (iii) a certified copy of the application for the trade-mark KLIK. I have noted that the above-mentioned applications all cover tobacco products. Further, the KLIK formative marks stand in the name of the first opponent PMPSA while the CLICK formative marks stand in the name of the present applicant British American Tobacco.

[4] The applicant elected not to file any evidence. Only the opponents filed a written argument and only the opponents were represented at an oral hearing held on April 29, 2014.

[5] As the applicant has participated only minimally in this proceeding, and as I will be finding for the opponents, my reasons for decision will be somewhat summary.

#### STATEMENT OF OPPOSITION

[6] Several grounds of opposition are alleged. One issue for decision, pursuant to s.16(3)(b) of the *Trade-marks Act*, is whether the applied-for mark CLICK SWITCH REFRESH THE TASTE is confusing with either of PMPSA's applications for the marks KLIK and KLIK PACK. In this regard, PMPSA's applications are based on proposed use in Canada, cover tobacco products (and related wares), and were filed before the subject application for the mark CLICK SWITCH REFRESH THE TASTE.

#### ASSESSING THE ISSUE OF CONFUSION

[7] I am in substantial agreement with the opponents' submissions at pages 6-9 of their written argument regarding the issue of confusion:

15. Subsection 16(3) provides that any applicant who has filed an application in accordance with s.30 for registration of a proposed trade-mark that is registrable is entitled to secure its registration, unless at the date of filing of the application it was confusing with a trade-mark or trade-name that had been previously used in Canada or made known in Canada by any other person or a trade-mark in respect of which an application for registration had been previously filed by any other person.

16. The material date for the consideration of the s. 16 ground of opposition is the date on which the Applicant filed the Subject Application, namely September 8, 2010.

17. It is submitted that as of the material date, the Subject Application was confusing with PMPSA's previously filed applications to register its KLIK and KLIK PACK trade-marks.

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22. In this case, the question is whether, as a matter of first impression, the "casual consumer somewhat in a hurry" who sees the Applicant's CLICK SWITCH REFRESH THE TASTE trade-mark, when that consumer has no more than an imperfect recollection of PMPSA's KLIK and KLIK PACK trade-marks for the identical wares, would be likely to be confused; that is, that this consumer would be likely to think that the source of the wares associated with the Subject Mark was one and the same source as the wares associated with PMPSA's KLIK and KLIK PACK trade-marks. As highlighted by Justice Binnie in *Masterpiece*, the Subject Mark and PMPSA's trade-marks are not to be carefully examined in a side by side comparison.

23. The Supreme Court affirmed that a comparison of the marks at issue when considering resemblance is to be approached by considering those aspects that define the trade-marks. It is the difference between or similarity with each of the parties' trade-marks that must be assessed. Furthermore, the "degree of resemblance" recognizes that marks with some differences may still result in a likely confusion.<sup>9</sup>

24. In this case, the word KLIK is the unique aspect that defines PMPSA's trade-marks, one of which consists solely of this word. The first component of the Subject Mark, namely CLICK, is orally identical and visually similar to the unique aspect that defines the PMPSA trade-marks.

25. It is a well accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction.<sup>10</sup>

26. A casual consumer observing the Subject Mark, and having no more than an imperfect recollection of PMPSA's KLIK and KLIK PACK trade-marks for the identical wares, would likely be confused into thinking that the source of the wares associated with the Subject Mark was one and the same as the source of the wares associated with PMPSA's trade-marks.

27. Apart from the degree of resemblance between the trade-marks at issue, the Board is to consider if any of the other factors enumerated in s. 6(5) of the Act [*Trade-marks Act*] reduce the likelihood of confusion to the point that confusion is not likely to occur. It is submitted that they do not; rather, if anything, the other factors increase a likelihood of confusion.

28. **Inherent distinctiveness:** PMPSA's KLIK and KLIK PACK trade-marks are inherently distinctive.

29. **Nature of wares and trade:** The wares of the parties are identical and would be sold in the same channels of trade.

30. **Length of time trade-marks have been in use:** The Subject Application and PMPSA's applications were each based on proposed use. There is no evidence of use of any of the trade-marks at issue in Canada.

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35. It is submitted that, at the date on which the Applicant filed the Subject Application, namely September 8, 2010, the Subject Mark was confusing with PMPSA's applications that had been previously filed.

[8] I agree with the above analysis of the s.6(5) factors and I therefore conclude that the applied-for mark is confusing with PMPSA's previously filed applications.

#### CONSIDERATION OF A FURTHER GROUND OF OPPOSITION

[9] The opponents also succeed on the ground of opposition pursuant to s.30(e) of the *Trade-marks Act* alleging that the applicant did not intend to use the applied-for mark **CLICK SWITCH REFRESH THE TASTE**. In this regard, the opponents have presented some evidence which indicates that the applicant intended to (i) market a new style of cigarette where the consumer could add menthol flavour by pressing on the filter portion to release small embedded menthol capsules, (ii) use the words "Click"; "Switch"; and "Refresh" in an instructional context to familiarize consumers with the new product rather than to use the complete phrase **CLICK SWITCH REFRESH THE TASTE** as a trade-mark. The opponents' evidence is sufficient to at least meet their low evidential threshold in respect of s.30(e) while the applicant has not challenged the opponents' evidence by cross-examination or with any of its own evidence.

[10] As I have decided in favour of the opponents on two grounds of opposition, it is

not necessary to consider the remaining grounds.

DISPOSITION

[11] In view of the foregoing, the application is refused. This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under s.63(3) of the *Trade-marks Act*.

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Myer Herzig, Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office